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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/855,775	05/16/2001	Kazuki Matsui	1405.1043	9121
21171 7590 12/31/2007 STAAS & HALSEY LLP SUITE 700 1201 NEW YORK AVENUE, N.W. WASHINGTON, DC 20005			EXAMINER CARLSON, JEFFREY D	
			ART UNIT 3622	PAPER NUMBER
			MAIL DATE 12/31/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 09/855,775	Applicant(s) MATSUI ET AL.	
	Examiner Jeffrey D. Carlson	Art Unit 3622	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 June 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3, 6-12 and 15-18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3, 6-12 and 15-18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Objections

1. Claim 1 is objected to because of the following informalities.
 - Claim 1, 2nd-to-last-line – “participate” should be replaced by “participates” and “initiate” should be replaced by “initiates”.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
3. Claims 2, 3, 11, 12, 17 are rejected under 35 U.S.C. 112, second paragraph, as indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
 - Claims 2, 11 are system (apparatus) claims, yet they include features which are presented as method steps rather than capabilities, rendering the claim scope uncertain. In these computer-based system claims, the best way to set forth apparatus structure is to claim *capabilities* of the apparatus by stating an element/module/subsystem is *programmed to <perform an act>* OR is *configured to <perform an act>*, rather than claiming the element actively performs the act. A claim covering both an apparatus and a method of using that apparatus is invalid because such a claim “is not sufficiently precise to

provide competitors with an accurate determination of the 'metes and bounds' of protection involved" and is "ambiguous." MPEP 2173.05(p)(ii).

- Claim 2, the computing unit should be claimed as "programmed to compute" and "programmed to notify" rather than "a computing unit **computing...and notifying.**"
- Claim 11, similar fixes should be made for the steps of "storing" and "sending".
- Claim 2, the last paragraph is confusing in that it appears that at least a portion, if not all of these limitations are already set forth in claim 2; it is not clear how the final paragraph further limits the claim.
- Claim 17, there is no antecedent basis in the 5th paragraph for "the request from the intermediating terminal", nor antecedent basis in the 6th paragraph for "the received symbol identifier".
- Claim 17, the 5th and 6th paragraphs ("requesting..." and "sending, from...") are generally confusing in scope. For example, it is not clear which entity in the 5th paragraph is sending the request and which is receiving the request.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the

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applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. **As best understood, claim 17 is rejected under 35 U.S.C. 102(e) as anticipated by Bezos (U.S. Patent No. 6,525,747).**

7. Regarding claim 17, Bezos teaches Applicants' claimed invention, including furnishing network resource symbols to the user terminals (FIG. 1); setting up in advance a correspondence table in which identifiers for the virtual spaces and identifiers for the symbols are correlated (FIG. 11 at 1105); providing an intermediating terminal enabling communication with the user terminals, and based on the correspondence table enabling conversion between the symbol identifiers and the virtual-space identifiers (FIG. 9 at 904); sending the symbol identifiers from the user terminals to the intermediating terminal (FIG. 1); and reporting from the intermediating terminal to the user terminals the virtual-space identifiers that correspond to the symbols (FIGs. 5-7, 12), wherein based on the reported virtual-space identifiers the user terminals participate in the virtual spaces and initiate communication with other user terminals having the same symbols (FIGs. 12-13). The steps of sending an acquisition request,

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requesting a symbol identifier and sending the symbol identifier are inherently met by the process of a second user navigating to the web page for a particular item, receiving from the server the visual symbols to join a discussion (with at least a first user) as well as the underlying code/identifiers that when clicked by the second user, enable the user to join user one in the virtual discussion space in accordance with the predetermined correspondence table of Bezos.

8. Claim 18 is rejected under 35 U.S.C. 102(e) as anticipated by Bezos (U.S. Patent No. 6,525,747) or, in the alternative, under 35 U.S.C. 103(a) as obvious over Bezos.

9. Regarding claim 18, generally, Bezos teaches shopping (merchandise) related discussions (chat) conducted using hyperlinked (identifiers) text (symbols) among shoppers using a server (communication intermediating device) including tables based on Item/Participant/Discussion IDs (a correspondence table). The merchandise includes symbols representative of the merchandise, including at least 101 of fig 1. The link to join a discussion (104 – fig 1) for that merchandise item represents a virtual chat space identifier as this leads the user to a virtual discussion where the user can communicate with others virtually about the item. This email-based discussion is taken to represent a “chat”¹. However, it would have been obvious to one of ordinary skill at the time of the invention to have provided any well known means for user-to-user electronic discussion, including an IRC chat as is generally well known and established.

Allowable Subject Matter

Claims 1-3, 6-12, 15, 16 appear to contain allowable subject matter. Some of these claims however cannot be allowed until the 112P2 rejections and/or the claim objection is overcome.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffrey D. Carlson whose telephone number is 571-272-


¹ Chat – To converse in an informal or familiar way. An informal or familiar conversation. Webster's II

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6716. The examiner can normally be reached on Mon-Fri 8a-5:30p, (work from home on Thursdays).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on (571)272-6724. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


Jeffrey D. Carlson
Primary Examiner
Art Unit 3622

jdc